

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action in which all claims were rejected. Applicants respectfully request reconsideration in view of the following:

THE REJECTIONS UNDER 35 U.S.C. §102

Regarding the rejection under 35 U.S.C. §102 of claims 1-3, Applicants have amended claim 1 to incorporate the limitation that *"the bar codes represent product identifying information"*. As noted on page 3 of the Office Action at the end of the second paragraph, the Office Action admits that *"Takahashi fails to disclose the bar code reader is a product identification reader."* Thus, it is submitted that this amendment, to incorporate this limitation that the bar codes represent product identifying information distinguishes over the Takahashi reference. Reconsideration and allowance is thus respectfully requested.

Additionally, the features of claims 2-4 have been incorporated into claim 1 (claims 2-4 have been rewritten) along with additional features associated with the functionality of a server residing at a television service provider headend and its use in registration of a product with multiple vendors. These features are discussed in arguments associated with claim 19. Accordingly, reconsideration of claims 1-3 as amended is respectfully requested.

Regarding the rejection under 35 U.S.C. §102 of claims 35-37, Applicants again note that the Office Action admits in specific reference to claim 35 that *"Takahashi fails to disclose the bar code reader is a product identification reader."* Thus, it is submitted that the rejection to claims 35-37 on the basis of 35 U.S.C. §102 is fatally flawed since Takahashi fails to show each and every feature of the claimed invention, as required to establish an anticipation rejection. In view of this flaw, amendments to the claims are unnecessary. Reconsideration and allowance is respectfully requested.

However, in order to further distinguish over the cited art, Applicants submit substantial amendments to claims 35-37 not necessitated by the current rejection. These amendments are similar to those presented in claim 1 and are more directly targeted at certain preferred embodiments and are believed to clearly distinguish over the cited art. Accordingly, the above discussion is equally applicable. Reconsideration and allowance of amended claims 35-37 is respectfully requested.

Regarding the rejection under 35 U.S.C. §102 of claims 29 and 34, Applicants have substantially amended claim 29 along the lines of claim 19 and believes the claim to distinguish over the cited art for at least the reasons cited below in the arguments relating to claim 19. Accordingly, reconsideration and allowance of claims 29 and 34 is respectfully requested.

THE REJECTIONS UNDER 35 U.S.C. §103

Regarding the rejection under 35 U.S.C. §103 of claims 4-6 and 38-41, Applicants note that the above comments and arguments relating to claims 1 and 35 are equally applicable. Moreover, claims 4 and 38 have been substantially rewritten. Reconsideration and allowance of claims 4-6 and 38-41 is respectfully requested.

Regarding the rejection under 35 U.S.C. §103 of claims 7, 8 and 9, Applicants have amended claim 7 to require use of a quote server residing at the television service provider as the mechanism for management of the RFQ and quotes. The combination of Giovannoli and White, as cited in the rejection, fail to disclose that the quote server resides at the television service provider headend. This is clearly disclosed in Fig. 1 and associated text of the specification and clearly involves no new matter. In the proposed combination, the STB of White simply serves to provide for connection through the television service provider to the Internet. While such Internet connections using a television service provider have become commonplace, Applicants find no suggestion in the art of carrying out bid services at the television service provider, as amended. This leads, in certain embodiments, to facilitating local businesses to target goods and services

to local consumers due to the more localized nature of the television service provider (e.g., the local cable TV company). This is contrary to general trends in providing such communication services via the Internet and, in certain embodiments, facilitates use of a STB and television without need for a separate computer system, thus potentially attracting a different set of consumers. In view of these distinctions, claim 7 is believed to distinguish over the cited art. Claims 8 and 9 being dependent on claim 7, they too are believed to distinguish over the cited art. Accordingly, reconsideration and allowance of claims 7-9 is respectfully requested.

Regarding the rejection under 35 U.S.C. §103 of claims 10-18, Applicants respectfully request reconsideration in view of the amendments to claim 7. While further arguments are possible to distinguish these claims over the cited art, such arguments are believed unnecessary in view of the amendment to claim 7.

Regarding the rejection under 35 U.S.C. §103 of claim 19, Applicants note that four separate references were required in the current rejection to attempt to meet all of the claim features and generate the current rejection. (In this case it is noted that the Office Action requires four references to assert the obviousness of a process that involves only six steps or acts.) While the undersigned recognizes that it is not dispositive of the issue, the citation of large numbers of references in order to establish a case of *prima facie* obviousness is at least highly suspect of a true case of *prima facie* obviousness.¹ Moreover, the larger the number of references required, the more suspect the case becomes. In order for the present rejection to properly establish a case of *prima facie* obviousness, there must be clear suggestion in the art to make the combination of these four references in the manner proposed by the Office Action to meet the claims.

In the present rejection, the Office Action cites various reasons to make the proposed combination (decreasing time to process rebates, providing marketing data,

¹See for example 150 USPQ 124, EASTERN ROTORCRAFT V. U.S., 207 USPQ 746, BANDANG V. LEWIS TIRES, and 216 USPQ 225, IN RE SPRING ASSEMBLIES

providing coupons and registering products). The undersigned notes that each of these reasons might more appropriately be categorized as advantages of certain embodiments of the present invention. Broad general statements of advantages (suggested only by the present application) of a resultant combination alone are not adequate reasons to motivate one of ordinary skill in the art to make such combinations in the absence of clear motivation in the art to do so. Even though the proposed combination may result in some advantage or beneficial result, there must be some teaching or suggestion in the prior art that one could expect such an advantage or beneficial result. The mere presence of such an advantage or beneficial result in the combination is not, in and of itself, adequate to establish that the combination or modification is obvious. Nor are broad statements of motivation to improve certain functions. In the present case, the only viable motivation is believed to be found within the bounds of Applicants' disclosure. Accordingly, it is believed that the Office Action falls short of establishing the *prima facie* obviousness of claim 19.

It is noted that it is well settled that the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art itself suggests the desirability of the modification. One cannot pick and choose elements from various references in order to cobble together a rejection in the absence of a clear motivation to make the proposed combination. The Examiner's attention is directed to MPEP 2143.01, particularly the sections entitled: "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION" and "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS" and "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS". With these references as guidance, it is believed clear that the present invention as characterized by claim 19 is not obvious in view of the cited references.

Further regarding claim 19, it is submitted that the Quinlan reference fails to adequately disclose a product registration process consistent with claim 19. The product registration process of Quinlan appears to be a registration with the manufacturer (e.g., a warranty registration). While this is not precluded by claim 19, claim 19 clearly requires that the “*matching the product registration data to a plurality of vendor registrations submitted by a plurality of vendors*” and “*at the television service provider, sending the product registration data to a plurality of matching vendors*”. That is, the product is registered with multiple vendors. By way of example and not limitation, the specification describes registering ownership of a musical instrument with local music stores so that special offers relevant to ownership of the instrument can be used to generate special offers from the music stores. This feature is believed to be neither taught nor suggested by the cited art.

In addition to the above, Applicants note that claim 19 is amended to clarify the nature of the service provider. This is entirely consistent with the use of the terminology in the specification and is believed to clearly involve no new matter. In view of the specification, the addition of the term “television” to “service provider” is clearly only adding that which is inherent in the language. In view of the above, reconsideration and allowance of claim 19 is respectfully requested at an early date.

Regarding the rejection under 35 U.S.C. §103 of claims 20-28, Applicants reiterate the above arguments and further note that in each of these rejections, yet another (fifth) reference is required in each case. Citation of five references is believed to even further stretch the bounds of reason as to whether these claims can truly be considered obvious to one of ordinary skill in the art. In view of this and the prior discussion, reconsideration and allowance is respectfully requested.

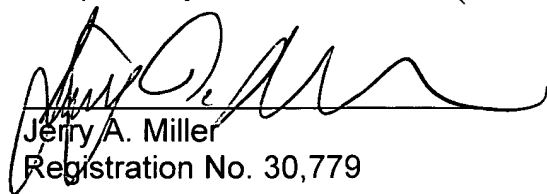
Regarding the rejections under 35 U.S.C. §103 of claims 30-33, Applicants respectfully request reconsideration for the reasons cited in connection with the

independent claim 29, and in further consideration of the additional subject matter added by claims 30-33.

The undersigned additionally notes that many other distinctions exist between the cited references and the invention as claimed. However, in view of the above arguments and amendments, further discussion of these deficiencies is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position. No amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references.

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. The undersigned further reiterates the request for interview presented above and earnestly solicits a dialog with the Examiner in order to bring this case to a speedy resolution.

Respectfully submitted,



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